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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named  
Inventor : Martin L. Plumer

Appln. No.: 10/039,201

Filed : January 4, 2002

Re: : BEVELED WRITING POLE OF A  
PERPENDICULAR WRITING ELEMENT

Socket No.: S01.12-0841/STL 10302

Group Art Unit: 3729

Examiner: Paul D. Kim



**RESPONSE**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I HEREBY CERTIFY THAT THIS PAPER IS BEING  
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28<sup>th</sup> DAY OF June, 2004.

  
PATENT ATTORNEY

This is in response to the Office Action mailed on June 10, 2004, in which the Examiner made the Restriction Requirement imposed in the Office Action mailed March 23, 2004 final and imposed a further restriction between two inventions of the non-withdrawn claims.

In Section 1 of the Office Action, the Examiner found the restriction of Group I, Species C to be proper and made it final. The Examiner also found Applicant's traversal of the restriction between Group I (claims 1-18) and Group II (claims 19-22) to be on the grounds that "all the claims as filed would not require additional searching, not place any undue burden on the patent office", but did not find the argument persuasive.

However, the Examiner failed to address Applicant's main argument regarding the restriction, which was presented in the Amendment filed April 23, 2004. In that response, Applicant argued that the inventions of Groups I and II are not distinct. In particular, the Examiner based the restriction on a finding that the product of Group II "can be made by another and materially different process such as without a polishing

process." However, such a polishing process is not required by the invention of Group I. For example, independent claim 1 of the invention of Group I does not contain the "polishing process" identified by the Examiner. Rather, independent claim 1 describes a method of forming the beveled writing pole of the invention of Group II, but without describing any specific process technique. Therefore, the inventions of Group I and Group II are believed to be sufficiently related such that they should be examined in the same case. Accordingly, Applicant requests that the requirement for restriction between inventions of Group I and Group II be withdrawn.

In Section 3 of the Office Action, the Examiner imposed an additional restriction between Invention I corresponding to claims 1, 3, 9-15, 17, 23-29, 32 and 33 that are drawn to a method of forming a beveled writing pole, and Invention II corresponding to claims 34 and 35 drawn to a method of forming a ramped step used in a method of forming a beveled writing pole. Applicant hereby elects, with traverse, to prosecute the claims of the Invention I, subject to reconsideration by the Examiner.

It is respectfully requested that the Examiner reconsider the requirement for restriction. At least portions of Invention I and Invention II are believed to be sufficiently related that they should be examined in one case. Even though slightly different in language, they are directed toward the same invention. In particular, the independent claims of Invention I describe a method of forming a beveled writing pole that includes a step of forming a ramped step, an embodiment of which is described in independent claim 34 of Invention II. Applicant respectfully disagrees with the Examiner's assessment that the method of Invention II "has separate utility such as a lift-off mask", since Applicant is unaware of any such separate utility. Moreover, the Examiner has failed to provide any support for the finding of separate utility by way of an example. Applicant

submits that the non-distinct inventions and the unsupported basis for the restriction renders the restriction improper, and requests that the restriction be withdrawn.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Brian D. Kaul, Reg. No. 41,885  
Suite 1600 - International Centre  
900 Second Avenue South  
Minneapolis, Minnesota 55402-3319  
Phone: (612) 334-3222 Fax: (612) 334-3312

BDK/djb